

Application No.: 10/823,790

AMENDMENTS TO THE DRAWINGS

The enclosed REPLACEMENT SHEETS (Exhibit A) address the drawing objections of the Examiner appearing at page 3 of the April 22, 2005 Office Action.

REMARKS

Claims 1, 3, 4, 7 and 9 through 15 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 9, 10 and 13. Claims 1, 3, 4, 7, 9, 11, 12 and 14 have been amended, claims 2, 5, 6 and 8 cancelled and new claim 15 added. In addition, the specification has been amended to address formalities and drawing corrections have been implemented (Exhibit A) in response to the Examiner's drawing objections. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure including the originally presented claims. Applicants submit that the present Amendment does not generate any new matter issue.

Objections to the Disclosure

The Examiner objected to the disclosure identifying various typographical oversights and informalities. In response the specification has been amended to address the informalities identified by the Examiner, thereby overcoming the stated bases for the objections to the disclosure. Accordingly, withdrawal of the objections to the disclosure is solicited.

Drawing Objections

The Examiner objected to the drawings identifying informalities with respect to reference characters. Applicants submit herewith the enclosed REPLACEMENT SHEETS (Exhibit A) responding to the Examiner's drawing objections. Accordingly, withdrawal of the objections to the drawings is solicited.

Claims Objections

The Examiner objected to claims 4 through 7, 11, 12 and 14 identifying perceived informalities. In response the claims have been amended addressing the issues raised by the Examiner, thereby overcoming the stated bases for the claim objections. Accordingly, withdrawal of the claim objections is solicited.

Claims 1 through 8 were rejected under 35 U.S.C. § 103 for obviousness predicated upon U.S. Patent No. 6,808,316 (Nakanishi et al.) in view of U.S. Patent No. 5,960,141 (Sasaki et al.).

This rejection is traversed.

Initially, as recognized by the Examiner, Applicants avail themselves of 35 U.S.C. § 103(c). Specifically, Nakanishi et al., which the Examiner asserts qualifies as prior art only under 35 U.S.C. § 102(e), does not preclude patentability under 35 U.S.C. § 103 because the subject matter of Nakanishi et al. and the claimed invention were, at the time the claimed invention was made, owned by the same person (Sumitomo Electric Industries, Ltd.) or subject to an obligation of assignment to the same person (Sumitomo Electric Industries, Ltd.). Accordingly, the imposed rejection under 35 U.S.C. § 103 is not legally viable.

Further, Applicants would point out that the present invention relates to an optical module in which the optical device with the fiber assembly and the electrical device are combined after independent assembly. In other words, the base mounts the optical device in the fiber assembly for optical alignment therebetween. However, the electrical device is mounted on the first substrate independent of mounting the optical device on the base. Combining the base and the first substrate is implemented by inserting the first substrate into the opening provided in

the base from the bottom to expose the electronic device mounted on the first substrate in the cavity. The base and the cover attach thereto form the cavity within which the optical device, the electrical device on the first substrate and the fiber assembly, to portion thereof, are secured.

Neither of the applied references discloses or suggests an optical module or assembly as claimed wherein the first substrate passes through the opening provided in the base.

Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1 through 8 under 35 U.S.C. § 103 for obviousness predicated upon Nakanishi et al. in view of Sasaki et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

New Claim 15

New claim 15 is free of the applied prior art for the reasons advanced in traversing the rejection of claims 1 through 8 under 35 U.S.C. §103. Specifically, Nakanishi et al. cannot be applied per 35 U.S.C. §103(c), and the combined disclosures of the applied references would not yield the claimed invention.

Applicants again acknowledge, with appreciation, the Examiner's allowance of claims 9, 10 and 13. Based upon the foregoing, it should be apparent that the imposed objections and rejection have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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